

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

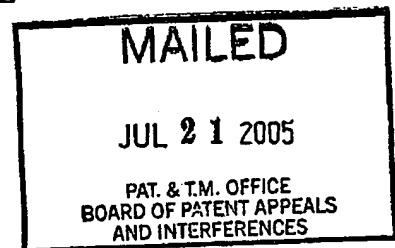
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NOBORU OKADA, HARUHISA HASEGAWA, TATSUYA TAKAOKA,
ICHIRO TAKASU, HISAYOSHI FUKUZAWA, SUSUMU IMAMIYA,
EIICHI IIDA and TOSHIHIKO TAKE

Appeal No. 2005-0818
Application No. 09/726,548

HEARD: May 4, 2005



Before KIMLIN, KRATZ, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

FOR FURTHER CONSIDERATION OF A REJECTION

We conclude that this application is not yet ready for our review. Further consideration of the rejection of record is required. Therefore, this application is hereby remanded to the Examiner, via the Office of a Director of the involved Technology Center, for appropriate action consistent with the following comments.

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Claim 1 is directed to a tire forming system. The claim is drafted using means plus function language. In footnote 4 of the Answer (Answer, p. 4), the Examiner states that “although the various ‘means’ in parts (1) to (6) of claim 1 use the phrase ‘means for,’ in each instance, the phrase ‘means for’ is modified by sufficient structure, material or acts for achieving the specified function (e.g. ‘inner liner supply means . . .’), and as such, 35 U.S.C. 112, sixth paragraph is not considered to have been invoked and has not been applied.”

It is well settled law that where a claim uses the word “means” to describe a limitation, it is presumed “that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses.” *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375, 65 USPQ2d 1865, 1874 (Fed. Cir. 2003) (quoting *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427, 44 USPQ2d 1103, 1109 (Fed. Cir. 1997)). “This presumption can be rebutted where the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety.” *Id.* In cases in which our reviewing court has found sufficient structure in the claims, the claim language specified a specific physical structure that performed the function. *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365, 54 USPQ2d 1449, 1452-53 (Fed. Cir. 2000) (holding a claim recited sufficient structure where the limitation was “second baffle means” because the phrase used the word “baffle” (a physical structure) and the claim “described the particular structure of this particular baffle”); *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303-04, 50 USPQ2d 1429, 1435-36 (Fed. Cir. 1999) (holding a claim recited sufficient structure where the limitation was “positioning means” and the claim

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“provid[ed] a list of the structure underlying the means”); *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531-32, 41 USPQ2d 1001, 1006-07 (Fed. Cir. 1996) (holding that the limitation “perforation means for tearing” was not a means-plus-function claim because the word “perforation” constituted sufficient structure).

Looking to claim 1, we do not find the type of structural limitations which would overcome the presumption that the statutory mandate of 35 U.S.C. § 112, ¶ 6 applies. In fact, there is very little pertinent structure recited in the means plus function clauses. Therefore, in accordance with the statutory mandate, it is necessary to construe the “means” language as limited to the corresponding structure disclosed in the specification and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) (*en banc*). Additional fact finding by the Examiner as well as a re-evaluation of issues under the statutory mandates of 35 U.S.C. §§ 112, ¶¶ 1 and 2 as well as 35 U.S.C. §§ 102 and 103 is necessary.

CONCLUSION

To summarize, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

An appeal conference as mandated by *MPEP* § 1208 (8th ed., rev. 1, May 2004) must be held before this case is subject to further appeal proceedings.

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED


EDWARD C. KIMLIN
Administrative Patent Judge


PETER F. KRATZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

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